NACZIW

CASE HM/5-21810/A/PCT/DIV

CERTIFICATE OF MAILING

hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Type or print name

Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Group Art Unit: 1617

WERNER HÖLZL ET AL

Examiner:

APPLICATION NO: 10/750,810

FILED: DECEMBER 31, 2003

FOR: MICROBICIDAL ACTIVE SUBSTANCES

Mail Stop Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PETITION FOR SUSPENSION OF RULES UNDER 37 CFR § 1.183

Sir:

The official filing receipt received in the above-identified application, having a mailing date of May 6, 2004 but date stamped as received by Applicants on July 1, 2004 (copy enclosed herewith), showed a date inconsistency with the Patent and Trademark Office (PTO) records under the Domestic Priority data as claimed by applicant information.

Applicants reviewed the file of the parent case Application No. 09/762,008. It is noted that the "Notification of Acceptance of Application Under 35 U.S.C 371", dated March 6, 2001 (copy enclosed herewith), correctly lists the 371 date for the parent case as February 1, 2001, not February 1, 2000.

But Applicants noted that the filing receipt, dated March 7, 2001 (copy enclosed herewith), listed the filing date in the box at the top of the page as February 1, 2000. This is where the error started, which was a clerical error made by the PTO. However, Applicants did not notice the incorrect filing date, so the PTO continued to use the incorrect date throughout the prosecution of the parent case. All the papers that were sent to the PTO during prosecution of the parent case by Applicants listed the 371 date correctly, and the error was never noticed until the inconsistency was mentioned on the filing receipt in the above-identified application. The filing papers in said application do list the lineage correctly (copy enclosed herewith).

In response to the date inconsistency on the above-mentioned official filing receipt, Applicants promptly submitted a Letter requesting correction on August 11, 2004. The PTO Response, mailed on September 7, 2004, indicted that a petition would be required to effect correction. Hence this petition is being timely filed.

Thus at this time, Applicants hereby petition for a suspension of the rules under 37 CFR § 1.183 and petition that the PTO issue a corrected filing receipt for the above-identified application wherein the phrase "(*)Data inconsistent with PTO records" is deleted for the reasons given above, and that the 371 date for Application No. 09/762,008 be changed to February 1, 2001 as listed on the Notice of Acceptance. The corrected filing receipt should read:

-- Domestic Priority date as claimed by applicant

This application is a DIV of 09/762,008 02/01/2001 PAT 6,689,372 which is a 371 of PCT/EP99/05449 07/30/1999 --.

While Applicants believe no fee should be required to correct an error made by the PTO, the Commissioner is hereby authorized to charge any fee under 37 CFR 1.17(h) that may be required to Deposit Account 03-1935.

Applicants believe that all requirements for a petition under 37 CFR § 1.183 have been met and respectfully request that their petition be granted. Please refer any questions to Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Kevin T. Mansfield

Reg. No. 31,635

Agent for Applicants

Kein J. Mansfield

Tevin T. Mansfield

Ciba Specialty Chemicals Corporation Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591-9005

(914) 785-7127 KTM/21810Dpet

Encls.: copy of filing receipt of present Application

copy of Notification of Acceptance of parent Application

copy of Transmittal letter of present Application copy of filing receipt of parent Application

Date: SEP 1 6 2004







UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

| MADE | ATES OF | • | | | |
|---|---|--|---------------------------|------------------|-------------------------|
| U.S. APPLICATION NO. | | FIRST NAM | ED APPLICANT | ; A | ITTY. DOCKET NO. |
| 09/762008 | | HOLZL | W | H. | M/2-21810/A |
| OANN VILLAMIZAR 40 WHITE PLAINS ROAD O BOX 2005 | RECE | EIVED | | PCT/EP99 | |
| TARRYTOWN, NY 10591 9005 | MAR S | 2001 | LA FILING | DATE | PRIORITY DATE |
| | | DECECCHIS DORDINATOR EPARTMENT | 30 JUI | L 99 | 04 AUG 98 06 MAR 20 |
| NOTIFICATION OF A The applicant is hereby advised the signated Office (37 CFR 1.494), | at the United S | CFR 1.494 OR States Patent and Office (37 CFR 1 | 1.495 Trademark Office | in its cap | acity as a |
| entified international application ha tentability examination in the Unit The United States Application No | ed States Pater | nt and Trademark | Office. | | |
| 01 FEB 2001 | | | | | ordina dutos arc. |
| 35 U.S.C. 102(e) DATE | | 01 FEB 2001 ATE OF RECEIP U.S.C. 371 REQ | | Ŷ. | |
| Filing Receipt (PTO-103X) will be PPEARING ON THE FILING RI AST OF THE 35 U.S.C. 371(C) R ATE IS SHOWN ABOVE. The fit the international application (Artic and all correspondence to the Group | ECEIPT AS T EQUIREMENT Ling date of the Cile 11(3) and 3 | THE "FILING D NTS HAS BEEN e above identified IS U.S.C. 363). O | ATE" IS THE D RECEIVED IN | ATE ON THE OF | WHICH THE FICE. THIS |
| A request for immediate exam application will be examined in tu | pination under rn. | 35 U.S.C. 371(f) | was received on | ; ; | and |
| The following items have been rec U.S. Basic National Fee. Copy of the international appli | | | | | |
| a non-English lang | guage. | | | | |
| Translation of the internationa Oath or Declaration of invento | application in | nto English. | | | |
| Conv of Article 10 amend | is(s) for DO/E | CO/US. | | | |
| Copy of Article 19 amendment | | ion of Article 19 | amendments into | English. | |

The Article 19 amendments have have not been entered.

The International Preliminary Examination Report in English and its Annexes, if any.

Copy of the Annexes to the International Preliminary Examination Report (IPER).

Translation of Annexes to the IPER into English.

The Annexes have have not been entered.

Preliminary amendment(s) filed ______01 FEB 2001 ______Information Disclosure Statement(s) filed______

Power of Attorney and/or Change of Address.

Assignment document.

Substitute specification filed



JAITTED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE tation Patriot and Tradismock Officer
MMISSIONER FOR PATENTS
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| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS | | |
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RECEIVED

CONFIRMATION NO. 1623

000324

CIBA SPECIALTY CHEMICALS CORPORATION

PATENT DEPARTMENT

540 WHITE PLAINS RD

P O BOX 2005 TARRYTOWN, NY 10591-9005 2004

FILING RECEIPT

OC000000012545462*

ANDREA DECECCHIS DOCKET COORDINATOR PATENT DEPARTMENT

Date Mailed: 05/06/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s) . .

Werner Holzi, Eschentzwiller, FRANCE; Marcel Schnyder, Birsfelden, SWITZERLAND:

Domestic Priority data as claimed by applicant

02/01/2001

This application is a DIV of 09/762,008 82/91/2000 PAT 6,689,372 * which is a 371 of PCT/EP99/05449 07/30/1999

(")Data provided by applicant is not consistent with PTO records.

Foreign Applications

EUROPEAN PATENT OFFICE (EPO) 98810749.6 08/04/1998

Projected Publication Date: To Be Determined - pending completion of Security Review

Non-Publication Request: No

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Hm15- 21810/A/PCT/Div

Preliminary Class

424

LICENSE FOR FOREIGN FILING UNDER Title 35, United States Code, Section 184 Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This ficense is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (i)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE WASHINGTON, D.C. 2023! www.uspta.gov

APPLICATION NUMBER

FILING DATE

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DRAWINGS TOT CLAIMS IND CLAIMS

09/762,008 🗸

02/01/2000

HM/2-21810/A

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324 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005

RECEIVED

MAR 1 3 2001

ANDREA DECECCHIS DOCKET COORDINATOR PATENT DEPARTMENT FILING RECEIPT

OC000000005837854*

Date Mailed: 03/07/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Wemer Holzl, Eschentzwiller, FRANCE: Marcel Schnyder, Birsfelden, SWITZERLAND:

Continuing Data as Claimed by Applicant

THIS APPLICATION IS A 371 OF PCT/EP99/05449 07/30/1999

Foreign Applications

EUROPEAN PATENT OFFICE (EPO) 98810749.6 08/04/1998

If Required, Foreign Filing License Granted 03/07/2001

Title

Microbicidal active substances

Preliminary Class

424

Copy sent to Back - LES. 4/40F 3/15/01 PD 2=21810/A/PCT

Data entry by : NGUYEN, SON

Team : OIPE

Date: 03/07/2001

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LICENSE FOR FOREIGN FILING UNDER Title 35, United States Code, Section 184 Title 37, Code of Federal Regulations, 5.11 & 5.15

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This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 36 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15 (b).

PLEASE NOTE the following information about the Filing Receipt:

- The articles such as "a," "an" and "the" are not included as the first words in the title of an application. They are considered to be unnecessary to the understanding of the title.
- The words "new," "improved," "improvements in" or "relating to" are not included as first words in the title of an application because a patent application, by nature, is a new idea or improvement.
- The title may be truncated if it consists of more than 600 characters (letters and spaces combined).
- The docket number allows a maximum of 25 characters.
- If your application was submitted under 37 CFR 1.10, your filing date should be the "date in" found on the Express Mail label. If there is a discrepancy, you should submit a request for a corrected Filing Receipt along with a copy of the Express Mail label showing the "date in."
- The title is recorded in sentence case.

Any corrections that may need to be done to your Filing Receipt should be directed to:



Assistant Commissioner for Patents Office of Initial Patent Examination Customer Service Center Washington, DC 20231

CASE HM/5-21810/A/PCT/DIV

St. J. July Fred Co.

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10 EL 803527 14 1 U5 "Express Mail" label mailing number

12 31 03 Date of Deposit

COMMISSIONER FOR PATENTS

P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop Patent Application

Sir:

Transmitted herewith for filing is the patent application of Inventor(s): WERNER HÖLZL AND MARCEL SCHNYDER

For: MICROBICIDAL ACTIVE SUBSTANCES

Enclosed are:

- $\boxtimes 20$ pages of the **certified English translation** of the specification including claims
- page(s) of the certified English translation of the abstract
- Declaration and Power of Attorney (copy) (For continuations/divisionals)
- Preliminary Amendment
- ☐ This application is a divisional of prior application No. 09/762,008 filed 2/1/01.
- The entire disclosure of the prior application, from which a copy of the declaration is supplied, is considered to be part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
- Amend the specification by inserting before the first line:
 - --This is a divisional of application Serial No. 09/762,008 filed on 2/1/01, still pending, which is a 371 of EP 99/05449 filed on 7/30/99.--

- Priority of application No(s). 98810749.6 filed on 8/4/98 respectively; in Europe(designating Germany) is claimed under 35 U.S.C. 119.

 A certified copy of each priority document is

 of record in application No. 09/762,008 filed 2/1/01.
- Prior to calculating the fees, kindly consider the attached preliminary amendment.

Filing Fee Calculation:

| Basic Fee Multiple Dependent Claims (\$290) | | | | | | \$770.00 | | |
|---|-----------------------|-----------------|-----|-----------------|-----|--------------|---|--------------|
| Muluple I | Dependent Claims (| \$290) | | | | | | |
| Foreign L | anguage Surcharge | e (\$130) | | | | | | |
| | For | Number Filed | | Number Extra | | Rate | 1 | |
| EXTRA Claims | TOTAL CLAIMS | 9 | -20 | 0 | + + | \$ 18 | | |
| | INDEPENDENT CLAIMS | 3 | -3 | 0 | | \$86 | = | |
| | | | | <u></u> | | AL FIL | | \$770.00 |

Please charge Deposit Account No. 03-1935 in the amount of \$770.00. Two additional copies of this paper are enclosed. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required, or credit any overpayment, to Account No. 03-1935.

Please address all correspondence to JoAnn Villamizar, Patent Department, Ciba Specialty Chemicals Corporation, 540 White Plains Road, P.O. Box 2005, Tarrytown, NY 10591-9005 and associate the attached application with **Customer Number 000324**. Please address all telephone calls to the undersigned at the number given below.

Respectfully submitted,

Kevin T. Mansfield

Agent for Applicant

Reg. No. 31,635

Ciba Specialty Chemicals Corporation Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591-9005 (914) 785-7127 KTM/am/



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UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address COMMISSIONER FOR PATENTS P.C. Dox 1450 Alexandris, Vigina 22313-1450 www.usptu.gov

APPLICATION NUMBER FILING OR 371(c) DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

10/750.810

12/31/2003

- Werner Holzl

HM/5-21810/A/PCT/DIV

000324

CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT

540 WHITE PLAINS RD

P O BOX 2005 TARRYTOWN, NY 10591-9005 RECEIVED

ANDREA DECECCHIS PATENT DEPARTMENT

CONFIRMATION NO. 1623

OC00000013737098

Date Mailed: 09/07/2004

RESPONSE TO REQUEST FOR CORRECTED FILING RECEIPT

Claims, Fees, and Inventors

In response to your request for a corrected Filing Receipt, the Office is unable to comply with the request because:

| The total number of claims appearing on the Filing Receipt does not include multiple dependent claims. The total fee appearing on the Filing Receipt includes the cost of multiple dependent claims that were present at the time the application was filed. |
|--|
| The filing fee is correct. It may include additional claims fees and/or the surcharge under 37 CFR 1.16 (e) for filing an oath/declaration or basic filing fee after the application filing date; or it may not reflect fees refunded to the applicant that were paid by mistake. |
| The number of claims reflected on the filing receipt is correct. Upon review of the claims, it was found that there was a miscalculation by the applicant. This may be due to improperly presented multiple dependent claims, typographical error, misnumbering of the claims, or other oversight. An amendment may be necessary to correct the problem. |
| The filing fee reflected on the filing receipt is correct. Applicant may have miscalculated the fees due. |
| Applicant calculated fees as other than small entity; however, applicant asserted small entity status in the application. Therefore, fees were applied as small entity and the remainder was refunded to the applicant. |
| The difference between the fees paid and the fees due was refunded to the applicant and will not be shown on the filing receipt. |
| The inventor information may be truncated if the family name consists of more than 50 characters |

Hm15-21810/A/POT/Div

| , Ø. | spaces combined). |
|------|---|
| | The inventor's residence allows for up to 40 characters (letters and spaces combined). |
| | The inventor's residence will only include the city and state for U.S. residences or city and country for residences outside the U.S. (See MPEP 605.02). |
| | A petition to correct the inventorship is needed to make this change. See 37 CFR 1.48. For non-provisional applications, the petition should be directed to the Director of the examining group assigned to your application. |
| | Changes made after submission of an executed declaration to the inventor information other than correction of typographical errors must be submitted in the form of a substitute declaration. Change of inventorship requires a petition under 37 CFR 1.48. |
| | The number of drawings shown on the filing receipt reflects the number of drawing sheets submitted and is not necessarily equal to the number of figures submitted. |
| | The correspondence address was captured as directed by applicant on filing. If you wish correspondence to be directed otherwise, please submit a request for a change of address. |
| | The docket number allows a maximum of 25 characters. |
| | The person signing on behalf of the deceased inventor is reflected on the Filing Receipt as the legal representative. |
| II/ | The filing date of a parent application cannot be changed by this request. A petition to correct the filing date in the parent application is required. |

Customer Service Center

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY